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Attn.: Mr. Jon P. Santamauro  
Director, US Patent & Trademark Office  
USPTO, Box 4  
Washington DC 20231

18Apr01  
01EGT026

Subject: Public Comment re Efforts to Harmonize Requirements of Patent Laws  
Ref.: Fed. Reg. 15409 (FR Doc. 01-6641/3-16-01)

Dear Mr. Santamauro:

I was generally opposed to the attempts to harmonize our US patent system when I gave public testimony on that subject to the then Director of the PTO, in 1993, in Crystal City. My objections were centered on the attempt to abandon our First-To-Invent (FTI) preference over the foreign First-To-File (FTF) scheme. I particularly pointed out, that with the growing use of the Internet information could be exchanged inadvertently or intentionally, and preempt a patent issue to the original inventor. There would be no recourse as many inventors overseas know, because any conflicts evident upon publication for opposition are biased to the FTF applicant, for essentially the same subject matter.

At the '93 hearing I suggested an alternative approach whereby all applicants would provide proof and affidavit showing date of reduction to practice of the claimed invention. However, to prevent bogus claims, I recommended that date be held secret by the Patent Office for a period of six years after issue of the patent while the file wrapper is opened. With the thrust to publication now in force, that could still be done, but now the period would be six years from the effective formal application filing date, whether or not the US application was published. The Patent Office would hold that date in confidence in the event another applicant claimed invention priority. This would apply to all applicants foreign or domestic.

As a default, if the applicant could not certify a date of reduction to practice with proof of diligence as excerpted from dated notes, the applicant's filing date would be the effective date of reduction to demonstrable practice. Essentially a FTF default! Thus this procedure would allow diligence and original invention to be recognized, by a-priori proofs.

I will provide "Other Comments" on the enclosed pages for consideration by the US representatives at Geneva in 2001.

Sincerely,



Edward G. Tuttle  
President/Consultant

Enclosures: 3 pages marked 01EGT026-01 to 03

Other Comments re Harmonization with regard to the 17 Issues provided in the "Request for Comments":

1. As to priority of invention: Best practice would be to harmonize with the US First-To-Invent (FTI) system, as it protects original inventor(s), who are diligent in their inventive process and can show a record date of reduction to practice. Diligence is required under US practice and proof is available to certify a declaration of invention. Foreign practice in large part allows others with inadvertent or actual privity to an invention, to file ahead of the true inventor(s) effectively negating diligent efforts of original inventors. Such practice is known and is made easier by the advent of the Internet. Protection of the original inventor rights is the ethical path all should follow. If however, the applicant can not provide declaratory proof of invention reduction to practice the applicant's date of filing a formal patent application becomes the effective date of reduction to practice. This is a default to the First-To-File regime for those who can not support an earlier date of invention reduction to practice.

In the event of a contested date the record of the declared date of reduction to practice would be held, in confidence, for six years from the original filing date to prevent bogus insupportable claims. This date information would be suppressed when the application is published for opposition.

If the proponents of FTF do not agree then the US should ask for a counter plan which will protect inventors, and not accept the vagaries of chance to determine priority of invention.

2. As to inventions deemed to be patentable: The US Constitution provides the test if the invention has a useful and tangible result. Foreign practice is to provide a "technical contribution" in order to be patentable, which can be subjective as to degree and the invention can be novel for the art but technically incremental over other inventions. The US useful and tangible practice even allows for novelty items which may not be considered "technical contributions".

3. As to enablement and "best mode" required in US practice: To those skilled in the art, under consideration, the invention described is credible as proscribed, and best mode declarations inhibit concealment and enhance technology transfer. The US practice is less ambiguous than some foreign practices among various examining authorities.

4. As to the content of claims: The US practice does not stipulate the technical fields toward which a claim may be directed. This is desirable as the claim may become relevant to new applications not foreseen by the applicant, yet directly applicable as a form of prior art.

5. As to multiple inventions: When such appear in a patent application, the US distinguishes on apparent independence and distinctiveness of inventive elements and does not seek to unify the invention. This is rational and allows useful partitions which can be more useful in some applications of the new art teachings. It would seem this is should be allowed alternative in PCT filings.

6. As to utility: The US requirement for patentability under 35USC101, is that the utility must be specific, substantial and credible. The foreign requirement for "industrial applicability" is archaic, as many novel inventions do not have immediate industrial applicability but are utilitarian, for an intended purpose which may not be industrial, as most in the English speaking world may interpret.

(Item 7 follows on 01EGT026-02)

7. As to global priority dates: In this era of the Internet and the World Wide Web a global priority date becomes practicable, for all applications world wide. There must be agreement on the language used in the application for standardization in defining the invention for global priority. As English is now the predominant commercial language, English is to be preferred. Over 50 years ago the world adopted English as the language for all airway communications for safety reasons. That rationale can be extended to this computer connected world with national preference assigned secondary status for the need for uniform understanding. Thus a filing date for a formal patent application can be made global and the time of filing be based on GMT, for purposes of establishment of FTF dates. This is not as important as to time when the US practice of FTI is enabled.

8. As to prior art with regard to novelty and obviousness: 35USC102(e) applies for published or issued patents. In effect when the world would reasonably have the opportunity to know of such "prior art". Some foreign offices determine prior art only with respect to novelty and allow possible multiple patents to obvious variations. Such practice could be a contravention of the concerns regarding multiple inventions expressed in item 5, above. The US practice is to be preferred as it is more defined as to novelty taken with obviousness considerations.

9. As to grace periods: US practice allows such a period of invention disclosure, in the US, for one year prior to formal patent application without a later patent defeating effect. Foreign practice requires absolute novelty which does not allow public disclosure of the invention prior to filing an application in any country. This long standing foreign practice has stopped US applicants from foreign patent acquisition. In fact the US Provisional Patent Application (PPA) uses the US "grace period", but it can inhibit foreign patent acquisition because of disclosure prior to the formal US filing. This is an old and respected difference but the problem is the US PPA which is not published, or incompletely defines the invention as is possible in a formal patent application. In this Internet era the US has an obligation of candor to its citizen inventors, advising of the possibility of rejection of an invention publicized prior to a formal US application filing, because of foreign absolute novelty rules. The days of in re Hilmer are passé.

10. As to geographical restrictions: The prior art considerations favor the direction of most member states seem inclined to take. The Internet era changes older paradigms which were created when the world was more insular. See commentary in item 9, above.

11. As to public use or sale prior to one year of filing a US patent application: The recently enacted Prior Users Rights legislation is counter to established world practice and negates legitimate inventor rights who timely disclose their inventions. The sanctity of the formal patent filing date must be preserved as it is used to establish priority of invention in the US and in foreign countries, and is a long standing practice. Any public use or sale beyond the one year prior to a formal filing would extend the US grace period and the patent term. The 20 year term is now the norm and its bounds must be maintained.

12. As to US novelty practice: The current US practice should not be changed to accommodate stricter and possibly ambiguous interpretations, used by others.

13. As to US obviousness determinations: 35USC103 sets forth a workable rationale with a track history. Foreign practice using a problem-solution approach is also reasonable, but the US test by those skilled in an art is better as it uses expertise in an art, and thereby allows recognition of what may not be obvious to a casual observer.

(Item 14 follows on 01EGT026-03)

14. As to US practice re multiple dependent claims: 35USC1.75(c) has been established and as such is a claim construction known to all who have received patent grants. It should not give way to foreign practice where multiple dependent claims may depend on other multiple dependent claims. Such practice leads to very complicated and obfuscating claim structures.

15. As to claims interpreted for validity: The US approach to interpretation where the language of the claim predominates, even in means plus function constructions which relates to the specifications of the patent. Foreign practice, at times, allows broader interpretations of invention scope, which also has some merit. However, since our claims are in English with its accepted nuances richness of definition the US practice is worthy of preservation. That is why English should be the target language for any interpretations of validity in patents filed in more than one country. Also see item 7 above.

16. As to US practice re "Doctrine of Equivalents": Festo is to be reckoned with as it appears to confine interpretation in post grant infringement cases. Attention should be paid to the EPC changes in this matter as it appears to be a studied work worthy of consideration.

17. As to US practice of granting patents to actual inventors and not assignees: This practice originates in our Constitution and recognizes the contribution of individuals. Filing of patent applications by owners of the patent can deny recognition of individuals and encourage false claims of inventorship, by people with economic control over inventors. The US practice enables candor and allows inventor claimants to be recognized as long as at least one claim in a patent is related to their acknowledged invention contribution.

Commentary is by Edward G. Tuttle, a US citizen resident in Orlando, Florida USA.

Sgn. Edward G. Tuttle Date 18 Apr 01